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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,893	01/09/2002	Desh Kapur	LEARP0122US	5724

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EXAMINER

LITHGOW, THOMAS M

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,893

Applicant(s)

KAPUR, DESH

Examiner

Thomas M. Lithgow

Art Unit

1724

Handwritten initials: d

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: *Handwritten signature: T. M. Lithgow*

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The specification designates the "filter chamber" as an area defined by the cover 13 which is engaged to the filter module housing 2 (pg. 3, line 25+). It is unclear how the "filter assembly" is "removably attachable to the filter chamber" as recited in claims 1, 19 and 20 when the chamber is not a structural element.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Pall (US 2945591). Pall'591 discloses a filter module with a

filter activated valve sleeve 19 acting as a shut-off valve and bypass valve 41.

4. Claims 1-2, 4 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Walton (US 2431782). Walton '782 discloses a filter module as shown in fig. 4-7 with a valve 23' acting as a shut-off valve and valve 38 being a bypass valve.

5. Claims 1-10, 14-15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Gutkowski (US 2978107). Gutkowski '107 discloses a combination shut-of valve and bypass valve acting as a single unit (valve spigot member 17). Fig. 1 shows the valve spigot member 17 in an operating position after being actuated by the filter member 21. Fig. 3 shows the valve spigot member in the closed position to prevent flow from the inlet from escaping while the filter is being changed and Fig. 4 shows the valve in a bypass position.

6. Claims 1-7, 10, 14-15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Pall (US 3040894). Pall '894 discloses a filter module with valve sleeve 59 which acts as a shut-off valve and bypass valve 81 as shown in figure 3.

7. Claims 1-3, 10, 14-16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (US 3080972). Smith '972 discloses a filter module with valve sleeve 41 acting as a shut-off valve and a bypass valve mechanism 31. There is a check valve 55 in the discharge channel to prevent drainage of filtrate when the bowl is removed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Gutkowski '107 or Pall '894 or Smith '972 as applied to claim 1 above, and further in view of Cooper (US 3591003). The use of a button indicator on the bottom of an aircraft hydraulic filter is taught by Cooper '003. Such an indicator alerts the operator to unsafe operating conditions and reminds the operator to service the filter device. To modify any of the above three aircraft hydraulic filters with the added safety

indicator device of Cooper '003 would have been obvious to one of ordinary skill in the art.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Gutkowski '107 or Pall '894 or Smith '972 as applied to claim 1 above, and further in view of Pall (US 3262563). Pall '563 teaches the benefit of employing a drainage valve at the bottom of an aircraft hydraulic fluid filter. The valve is employed to remove the fluid and pressure in the filter when preparing to remove the filter bowl for servicing (col. 8, line 15.). To so modify the prior art hydraulic fluid filters with such a safety device would have been obvious to one of ordinary skill at the time of the invention.

11. Claims 17-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Gutkowski '107 or Pall '894 or Smith '972 as applied to claim 1 above, and further in view of Klauck (US 4372849). Klauck '849 teaches the utility of combining a filter unit in the same housing with a pump unit as noted in the preamble. Applicant does not disclose the location of his pump unit in the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Lithgow whose

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telephone number is 571-272-1162. The examiner can normally be reached on Mon. -Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blain Copenheaver can be reached on 571-272-1156.



Thomas M. Lithgow
Primary Examiner
Art Unit 1724

TML